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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.  |
|--|-------------|----------------------|---------------------|-------------------|
| 10/588,854   | 08/09/2006  | Kenzo Kase           | 039371-18           | 2013              |
| 5179   | 7590        | 04/22/2010           | EXAMINER            |                   |
| PEACOCK MYERS, P.C.<br>201 THIRD STREET, N.W.<br>SUITE 1340<br>ALBUQUERQUE, NM 87102 |             |                      |                     | HICKS, VICTORIA J |
| 3772   |             | ART UNIT             |                     | PAPER NUMBER      |
| 04/22/2010   |             | MAIL DATE            |                     | DELIVERY MODE     |
|  |             |                      |                     | PAPER             |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/588,854             | KASE, KENZO         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | VICTORIA HICKS         | 3772                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 March 2010.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-30 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 August 2006 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

**This action is in response to the Request for Continued Examination (RCE)  
filed on March 8, 2010.**

Claims 1-18 were cancelled by Applicant.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/8/10 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 3/8/10 have been fully considered but they are not persuasive. In response to Applicant's argument that Kase does not disclose grooves that extend horizontally in the tape width direction, the Examiner points out that the grooves (6) have a width (please see Figures 2 and 3) and therefore, extend horizontally in the tape width direction. In response to Applicant's argument that Kase teaches away from the claimed grooves, the examiner notes that simply that there are differences between two references is insufficient to establish that such references

"teach away" from any combination thereof. *In re Beattie*, 974 F. 2d 1309, 1312-13, 24 USPQ2d, 1042 (Fed. Cir. 1992).

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation "the tape width direction" in line 4 of the claim and the limitation "the longitudinal direction" in line 5 of the claim. There is insufficient antecedent basis for these limitations in the claim.

2. Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21 and 22 recite the limitation "spacing between adjacent grooves" in line 1 of the claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Kase (US patent 5,861,348).

In regards to claim 19, Kase teaches in the abstract, Figures 1-3 and column 1, lines 40-45 a stretch base material (base cloth 2 formed of a stretchable wrap); an adhesive layer (5) comprising a plurality of grooves (gaps 6) disposed on said base material (2), wherein said grooves (6) extend horizontally in the tape width direction and are arranged in an array configuration in the longitudinal direction of said tape (1); said grooves (6) not containing adhesive (the base cloth is exposed) thereby facilitating breathability (permeability); and said grooves (6) not extending across the entire width of said tape (1) but having adhesive (5) between said grooves (6).

In regards to claim 20, Kase teaches the apparatus of claim 19. Kase teaches in Figure 1 that the length of said grooves (6) changes stepwise repeating a gradual increase and decrease in said tape (1) longitudinal direction.

In regards to claim 21, Kase teaches the apparatus of claim 19. In Figure 1, Kase teaches that the spacing between adjacent grooves (6) decreases stepwise from a shortest groove (6) toward the longest groove (6).

In regards to claim 22, Kase teaches the apparatus of claim 19. In Figure 1, Kase teaches that the spacing between adjacent grooves (6) increases stepwise from a shortest groove (6) toward the longest recessed groove (6).

In regards to claim 23, Kase teaches the apparatus of claim 19. Kase teaches in the abstract that the base material (base cloth) is exposed through the grooves (gaps).

In regards to claim 24, Kase teaches the apparatus of claim 19. Kase teaches in Figure 1 that the grooves (6) are disposed parallel (having the same tendency or direction) to each other.

In regards to claim 25, Kase teaches the apparatus of claim 19. In the abstract Kase teaches that the grooves (gaps 6) are on a stretchable base cloth. This would cause the width of said grooves (6) to change with expansion and contraction of the tape (1).

In regards to claim 26, Kase teaches the apparatus of claim 19. In the abstract Kase teaches that adhesive layer is on a stretchable base cloth. This would cause the thickness of said adhesive layer to change with expansion and contraction of said tape (1) thereby changing a dept of said grooves (6).

In regards to claim 27, Kase teaches the apparatus of claim 19. Kase teaches in Figure 2 and column 5, line 14 a peelable exfoliate layer (7) disposed on said adhesive layer (5).

In regards to claim 28, Kase teaches the apparatus of claim 19. Kase teaches in Figure 1 that the array comprises a repetitive pattern.

In regards to claim 29, Kase teaches the apparatus of claim 19. Kase teaches in Figure 1 that the grooves (6) are not arranged at regular spacing in said longitudinal direction.

In regards to claim 30, Kase teaches the apparatus of claim 19. Kase teaches in Figure 1 that the grooves (6) comprise different lengths.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA HICKS whose telephone number is (571)270-7033. The examiner can normally be reached on Monday through Thursday, 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. H./  
Examiner, Art Unit 3772  
4/13/10

/Patricia Bianco/  
Supervisory Patent Examiner, Art Unit 3772